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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

98-076-C1

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Application Number

10/649,180

Filed

August 27, 2003

First Named Inventor

Jay S. Walker

Art Unit

3711

Examiner

William M. Pierce

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 33,384

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



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November 10, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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## **PRE-APPEAL REQUEST FOR REVIEW**

Applicants respectfully request Pre-Appeal Review of the rejections set forth in the Final Office Action mailed August 8, 2008 (hereinafter the "Final Action"). An Amendment cancelling claims and making several minor changes to the pending claims, and a Notice of Appeal, are filed concurrently with this Request.

### **REMARKS**

#### **I. Introduction**

After entry of the Amendment cancelling claims 1-18 and 34, which is being filed concurrently with this Request, claims 19-21, 23-27, 29-33 and 35-43 are pending, and claims 19, 26, 32, 33 and 35 are the only independent claims (5 independent claims).

Review is requested for the reasons recited below. Please note that, in the arguments, claim limitations are indicated by *italics*.

#### **II. The Claim Rejections**

Pending claims 19-21, 23-27, 29-33 and 35-43 stand rejected under Section 102(e) or in the alternative under Section 103(a), for allegedly being obvious over Riendeau et al., U.S. Patent No. 6,761,633 (hereinafter "Riendeau") in view of Smith, U.S. Patent No. 5,411,260 (hereinafter "Smith"). Claim 12 was rejected under Section 103(a) in light of Riendeau and Sultan, U.S. Patent No. 6,273,817, but claim 12 has been cancelled and thus this rejection is moot.

#### **III. No *prima facie* case of Anticipation or Obviousness Has Been Established Due to the Improper Construction of Method Claims 19, 26 and 35 as Product-by-Process Claims**

The Examiner explicitly rejected the pending independent method claims based on the determination that each is a product-by-process claim (see Final Action, page 2, last paragraph). However, a product-by-process claim is a claim to a **product itself** (e.g., to an apparatus, device, manufacture or composition of matter), and **defines the claimed product in terms of the**

**process by which it is made** (Emphasis added, see MPEP §2173.05(p)(I)). Appellants respectfully submit that none of the independent method claims 19, 26 and 35 fit this definition. Thus, the rejections of independent claims 19, 26, 32, 33 and 35 (and dependent claims 20, 21, 23-25, 27, 29-31 and 35-43) under Section 102(a)/Section 103(a) are based on the erroneous determination that the independent method claims are product-by-process claims, and the subsequently erroneous conclusion that limitations concerning the "rules of play" do not distinguish over Riendeau, ostensibly because such limitations do not imply "structure."

In particular, claim 19, which was not specifically addressed in the Final Action, is directed to *A method for facilitating game play of a simulated scratch-off lottery ticket on an electronic device*. Claim 19 then recites the following **process**:

*generating a pattern of nodes in a play area of the simulated scratch-off lottery ticket, ... wherein at least two nodes in the pattern that are adjacent to one another do not together form a portion of an available path, and further wherein any one of the nodes [in the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket;*

*causing the at least one symbol within a perimeter of a node to be concealed from view...;*

*receiving an indication that a player has completed a game comprising the generated pattern of nodes;*

*determining whether the player is eligible for a prize...; and*

*outputting an indication of whether the player is eligible for a prize.*

On its face, independent claim 19 is **not** a product claim, and thus Appellants respectfully assert that the Examiner has fundamentally misconstrued claim 19 as being a product-by-process claim. The same faulty logic has been applied to method claims 26 and 35 and, as a result, the particular limitations of these method claims have been **ignored** because they allegedly do not imply "structure" to a product. Specifically, the Examiner stated:

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production." (Final Action, page 3, paragraph 1).

But the determination of patentability of these method claims **must** be based on the recited process steps, not on an end-product the Examiner believes may be produced by the steps. Accordingly, the Examiner has not established a *prima facie* case of obviousness for any of claims 19-21, 23-27, 29-33 and 35-43.

**IV. A prima facie Case of Anticipation or of Obviousness Has Not Been Established for Any of the Pending Claims**

Riendeau does *not* teach or suggest all of the features of independent claims 19, 26, 32, 33 and 35, as set forth immediately below.

In particular, independent claim 19 includes a feature of:

- *wherein any one of the nodes [in the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

Claims 20, 21 and 23-25 incorporate by reference the above limitation of claim 19.

Similarly, independent claim 26 includes a feature of:

- *wherein any one of the nodes [spanning the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

Claims 27 and 29-31 incorporate by reference the above limitation of claim 26. In addition, independent computer readable medium claim 32 is encoded with instructions that direct a processor to practice the process of claim 26, and apparatus claim 33 includes a processor and a storage device storing a program to direct a processor to practice the process of claim 26.

Independent method claim 35, directed to *A method for providing a scratch-off lottery game*, includes the feature of:

- *wherein in accordance with a game rule associated with the lottery game any one of the plurality of game elements printed in the play area of the lottery game is selectable as an initial player selection;*

Claims 36-43 incorporate by reference the above limitation of claim 35. In fact, the Examiner did not specifically address any of the limitations of claim 35 in the Final Action.

Appellants respectfully submit that Riendeau does not teach that any one of the plurality of play symbols or nodes in the play area of a ticket is selectable by a player *as an initial player selection*. But the Examiner states that:

“Riendeau inherently shows ... the capability... any one of the plurality of play symbols printed in the play area of the lottery ticket is selectable as an initial player selection.” (See Final Action, page 3, second paragraph)

Appellants disagree. Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing descriptive material **is necessarily present, not merely probably or possibly present**, in the prior art. Emphasis added, see *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). Thus, the question raised by the Examiner is whether one skilled in the art would read any portion of Riendeau as **necessarily, not probably or possibly**, showing a process (or processes) that included every feature of claims 19, 26 and 35. But there is no explanation of how Riendeau “inherently” (i.e., necessarily) teaches what the Examiner asserts.

To the contrary, Riendeau specifically teaches that a player must make a first selection at the start of the game from one of the designated “nodes”. Thus, a player cannot select any one of the depicted “nodes” or points in the play area at the start of the game. For example, a player could not first select a “finishing point” in Riendeau, and could not initially select some other mid-point in the displayed branches. [See Abstract of Riendeau, which teaches: “as play progresses between a starting point and multiple finishing points”; See also, Fig. 1, Figs. 2A-2B (“START” 52); and see Col. 7, lines 1-4 (“According to a sample game, the player’s current position is marked using a marker (herein depicted as a star) at a starting point 52 (see FIG. 2A). From there the player must choose between a first branch 62 and a second branch 64.”) (emphasis added)].

Appellants also respectfully assert that Smith fails to teach or suggest any of the features of claims 19, 26 and 35 highlighted above. But the Examiner contends:

“Smith show (sic. “shows”) where “any one of the plurality of play symbols... is selectable” as indicated by the travel card 14.” (See page 3, paragraph 5 of the Final Action)

The above statement is **incorrect**, as there is no portion of Smith that supports such an interpretation. In fact, Smith pertains to a maze-type game having a first grid 14 that **dictates** how the player “travels” when playing and uncovering the boxes of a second grid 30 (see Smith, col. 3, lines 1-8 and Fig. 1). In stark contrast to that required by the pending claims, Smith

teaches a game wherein a player only removes opaque coatings of the second grid that **match** any of the symbols of a first grid (see col. 4, lines 15-25). Thus, the disclosure of Smith as been **misconstrued**, as this reference actually **teaches away** from permitting a player to select any play symbol printed in the play area of a lottery ticket.

In view of the above remarks, Appellants respectfully submit that the Examiner has **not** established with substantial evidence that all of the features of independent claims 19, 26, 32, 33 or 35 were known. Accordingly, a *prima facie* case of anticipation and/or of obviousness has **not** been established for claims 19 (and its dependent claims 20, 21 and 23-25), 26 (and its dependent claims 27 and 29-31), 32, 33 and 35 (and its dependent claims 36-43).

Thus, in view of the above remarks, Appellants respectfully submit that the Section 102(e) and/or the Section 103(a) rejections of claims 19-21, 23-27, 29-33 and 35-43 cannot stand and should be reversed.

#### **IV. Conclusion**

Appellants respectfully request pre-appeal review and reversal of all of the rejections of the pending claims.

Respectfully submitted,

November 10, 2008  
Date

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